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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,620	02/04/2004	Jonathan M. Graff	UN1919/4-8US	9412
7590 M. Michelle Muller VINSON & ELKINS LLP 2300 First City Tower 1001 Fannin Houston, TX 77002-6760			EXAMINER REDDIG, PETER J	
			ART UNIT 1642	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/771,620	Applicant(s) GRAFF ET AL.	
	Examiner Peter J. Reddig	Art Unit 1642	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

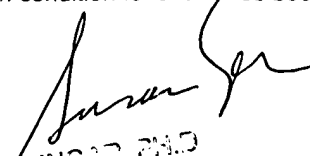
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-12, 14, 56, 58 and 61-65.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____


 SUBMITTED AND
 PRIMARY EXAMINER

Continuation of 3. NOTE: The amendments to the claims raise the issue of new matter and thus the amendments to the claims will not be entered.

The limitation of the full length complement of SEQ ID NO: 3 or 4 in the claimed method does not have support in the specification and claims as originally filed.

Applicants argue that the complement to the disclosed sequences is well understood in the art to be the nucleotide sequence that consists of the Watson-Crick base pairing complements running in the opposite 5'-3' orientation. The use of complementary sequences is supported at least in [0078].

Applicants arguments have been considered, but have not been found persuasive. A review of paragraph 0078 does not reveal support for the full length complement of SEQ ID NO: 3 or 4 because 0078 does not refer to complementary sequences in any way:

[0078] Methods and kits of the present invention can be used, for example, to monitor the progression of breast or ovarian cancer in a subject. A sample from a subject is obtained at a first point in time and a sample is also obtained at a subsequent point in time. The expression pattern of CXCL9 or FLJ20174, or both, is determined for both samples and compared. The comparison allows for the monitoring of the progression of breast or ovarian cancer in a subject. For example, the first sample can be obtained prior to chemotherapy or other treatment and a subsequent sample obtained after the therapy or treatment. The methods and kits therefore allow for a determination of any changes in the progression or status of the disease after treatment.

Thus, paragraph 0078 does not provide support for the full length complement of SEQ ID NO: 3 or 4. Although complementary sequences are well understood in the art to be the nucleotide sequence that consists of the Watson-Crick base pairing complements running in the opposite 5'-3' orientation and would be obvious, this does not provide support for the newly claimed limitation as neither the specification nor claims as originally filed contemplate the full length complement of SEQ ID NO: 3 or 4.

Claims 1-12, 14, 56, 58, and 61-65 remain rejected under 35 USC112, first paragraph, for the reasons previously set forth in the Office Action of July 10, 2007, section 4, pages 2-4.

Applicants argue that the amendments of the claims put them in condition for allowance.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the rejections remain for the reasons previously set forth.

Claims 1-8, 14, 56, 58, and 65 remain rejected under 35 USC112, first paragraph, for the reasons previously set forth in the Office Action of July 10, 2007, section 5 pages 4-6.

Applicants argue that the amendments of the claims put them in condition for allowance.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the arguments are moot and the rejections remain for the reasons previously set forth.

Claims 1-9, 14, 56, 58, and 65 remain rejected under 35 USC112, first paragraph, for the reasons previously set forth in the Office Action of July 10, 2007, section 6 pages 6-7.

Applicants argue that the amendments of the claims put them in condition for allowance.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the arguments are moot and the rejections remain for the reasons previously set forth.

Claims 62-64 remain rejected under 35 USC112, first paragraph, for the reasons previously set forth in the Office Action of July 10, 2007, section 7 pages 7-8.

Applicants argue that the amendments of the claims put them in condition for allowance.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the arguments are moot and the rejections remain for the reasons previously set forth.

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